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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,040	02/01/2002	David Michael Goldstein	R0038H-CON	3728

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INTELLECTUAL PROPERTY LAW DEPT., MS A2-250  
PALO ALTO, CA 94304-9819

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT PAPER NUMBER

1626

DATE MAILED: 06/13/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~which~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-17 and 19-32 are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
☐ Claim(s) \_\_\_\_\_ is/are allowed.  
☒ Claim(s) 1-17 and 19-32 are rejected.  
☐ Claim(s) \_\_\_\_\_ is/are objected to.  
☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of Reference Cited, PTO-892  
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s): 3  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

10/066,040

## DETAILED ACTION

Claims 1-17 and 19-32 are pending in the application.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 and 19-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1, 2, 16 and 17, Applicants have amended the definition of R<sup>3</sup> to recite, a "heteroalkyl substituted with a heteroaryl or heterocyclyl" group. No support in the instant specification or the originally filed claims could be found for the R<sup>3</sup> variables representing a

“heteroalkyl substituted with a heteroaryl or heterocyclyl” group.

Applicants have not indicated (page number and line number) where support for this language could be found. Therefore, the claims lack written description as such.

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 17 and 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 and 17 lack antecedent basis from claim 1 since claim 1 states that R<sup>3</sup> is a heteroalkyl substituted with a heteroaryl or heterocyclyl group. However, claims 16 and 17 state that R<sup>3</sup> is heteroalkyl optionally substituted with a heteroaryl or heterocyclyl group. Claims 19-21 depend from cancelled claim 18. Claims 22-24 fail

to further limit claim 16 since claim 16 does not claim that R<sup>3</sup> is a heteroalkoxy group.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faraci et al. {WO 94/13643}. WO 94/13643 is in the same patent family as U.S. Pat. 5,712,303 which is listed on the 1449 Form.

#### *Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim pyrazole products. Faraci et al. teach pyrazole products that are structurally similar to the instant claimed pyrazole products. See in Faraci et al., for example, wherein A is -C(=O), R<sub>1</sub> is amino, R<sub>2</sub> is alkyl, R<sub>3</sub> is phenyl substituted with a acetyl-alkyl group and

R<sub>4</sub> is halophenyl (pages 1 and 2). Also see, for example, the products on page 36, line 10; page 40, line 15; page 43, line 19; and page 44, lines 12-14. Faraci et al. teach that the pyrazole products are useful in treating disorders such as inflammatory disorders and immune suppression (page 5, lines 1-12).

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the products in the prior art and the instantly claimed products is that of generic description.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

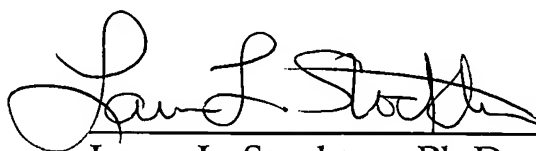
The indiscriminate selection of “some” among “many” is *prima facie* obvious. The motivation to make the pyrazole products derives from the expectation that structurally similar products would possess similar activity (e.g. an anti-inflammatory). One skilled in the art would thus be motivated to prepare products embraced by Faraci et al. to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating inflammatory

disorders. Therefore, the instant claimed products would have been suggested to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in black ink, appearing to read 'Laura L. Stockton', written over a horizontal line.

Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

June 13, 2002